



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/870,375	05/30/2001	Vcronique Gruber	18433/2022	7238

29933 7590 10/02/2003  
PALMER & DODGE, LLP  
KATHLEEN M. WILLIAMS  
111 HUNTINGTON AVENUE  
BOSTON, MA 02199

EXAMINER

LAMBERTSON, DAVID A

ART UNIT PAPER NUMBER

1636

8

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/870,375

Applicant(s)

GRUBER ET AL.

Examiner

David A. Lambertson

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-61 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claims 2-4, 8-28, 30, 31, 33, 35, 36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 1, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
2. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 2, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
3. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 3, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
4. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 4, a cell comprising said chimeric promoter or vector, a method of making said cell,

and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.

5. Claims 2, 3, 5, 8-30, 32, 34-36, 37 (as it reads on pMRT1177, which comprises SEQ ID NO: 5) and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 5, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
6. Claims 2, 3, 5, 8-30, 32, 34-36, 37 (as it reads on pMRT1178, which comprises SEQ ID NO: 6) and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 6, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
7. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 7, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
8. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 8, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.

9. Claims 2, 3, 5, 8-30, 32, 34-36, 37 (as it reads on pMRT1179, which comprises SEQ ID NO: 9) and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 9, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
10. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 10, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
11. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 11, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
12. Claims 2, 3, 5, 8-30, 32, 34-36, 37 (as it reads on pMRT1180, which comprises SEQ ID NO: 12) and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 12, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
13. Claims 2, 3, 5, 8-30, 32, 34-36, 37 (as it reads on pMRT1207 and pMRT1181, which both comprise SEQ ID NO: 13 and 46-61, drawn to a chimeric promoter,

expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 13,  
a cell comprising said chimeric promoter or vector, a method of making said cell,  
and a method of expressing a nucleic acid using said vector, classified in class  
435, subclass 320.1.

14. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter,  
expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 14,  
a cell comprising said chimeric promoter or vector, a method of making said cell,  
and a method of expressing a nucleic acid using said vector, classified in class  
435, subclass 320.1.
15. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter,  
expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 15,  
a cell comprising said chimeric promoter or vector, a method of making said cell,  
and a method of expressing a nucleic acid using said vector, classified in class  
435, subclass 320.1.
16. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter,  
expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 16,  
a cell comprising said chimeric promoter or vector, a method of making said cell,  
and a method of expressing a nucleic acid using said vector, classified in class  
435, subclass 320.1.
17. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter,  
expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 17,  
a cell comprising said chimeric promoter or vector, a method of making said cell,

and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.

18. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 18, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
19. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 19, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
20. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 20, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
21. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 21, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.

Art Unit: 1636

22. Claims 2, 3, 5, 8-30, 32, 34-36 and 46-61, drawn to a chimeric promoter, expression cassette, isolated nucleic acid and vector comprising SEQ ID NO: 22, a cell comprising said chimeric promoter or vector, a method of making said cell, and a method of expressing a nucleic acid using said vector, classified in class 435, subclass 320.1.
23. Claims 38-43, drawn to a transgenic plant, classified in class 800, subclass 295.
24. Claims 44-45, drawn to a propagule of a transgenic plant, classified in class 800, subclass 298.

Claims 1, 6 and 7 link(s) the inventions of Groups 1-22. Claims 1, 6 and 7 will be examined upon the election of one of Groups 1-22. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), claims 1, 6 and 7. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Art Unit: 1636

Pursuant to 35 U.S.C. 121 and 37 C.F.R. 1.141, the sequences listed in claim 4, 5, 29, 31-34 are subject to restriction. The Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such sequences to be claimed in a single application. Under this policy, a single independent and distinct sequence will be examined in a single application.

Claims 4, 5, 29, and 31-34 specifically claim the nucleotide sequences identified as SEQ ID NOS: 1-22. The sequences are considered to be unrelated since each sequence claimed is structurally and functionally independent and distinct for the following reasons: each of the sequences has a distinct nucleotide sequence, such that a search of one sequence will not result in the identification of art on all other sequences. Furthermore, a search of more than one (1) of the sequences claimed presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and corresponding examination of more than one (1) of the claimed sequences. In view of the foregoing, one (1) sequence is considered to be a reasonable number of sequences for examination. Accordingly, applicant is required to elect one (1) sequence when electing Group 23 or 24 as set forth above. It is noted that for applicant's convenience, especially with regard to matching the particular vectors of claim 37, these sequences have been separated into individual groups as it regards the first appearing invention (i.e., the chimeric promoter, expression cassette, isolated nucleic acid, vector, cell comprising said chimeric promoter or vector, method of making said cell, and method of expressing a nucleic acid using said vector). This is NOT an election of species.

Art Unit: 1636

The inventions are distinct, each from the other because of the following reasons:

Inventions 1-22 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and are not disclosed as capable of being used together. Specifically, each of inventions 1-22 makes use of a different chimeric promoter having a distinct chemical structure by virtue of their distinct nucleotide sequences. Furthermore, as indicated above, the Commissioner has partially waived the requirements of 37 C.F.R. 1.141 and will permit a reasonable number of such sequences to be claimed in a single application. Under this policy, a single independent and distinct sequence will be examined in a single application. As a result, the different sequences have a different structure-function relationship, and are therefore patentably distinct.

Inventions 1-22 and 23-24 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and are not disclosed as capable of being used together. Specifically, inventions 1-22 are drawn to promoters, vectors, etc., which have the function of expressing a nucleotide sequences, while invention 23 is a complex organism whose function is survival and invention 24 is a seed whose function is to reproduce the organism from where it is spawned. As a result, the inventions are patentably distinct.

Art Unit: 1636

Inventions 23 and 24 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different functions and are not disclosed as capable of being used together. Specifically, invention 23 is a complex organism whose function is survival and invention 24 is a seed whose function is to reproduce the organism from where it is spawned, which are clearly independent functions. As a result, the inventions are patentably distinct.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper. Furthermore, especially in instances where the classifications are the same, the non-patent literature searches required for each of these inventions are not co-extensive, hence said searches would be burdensome. Therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

Art Unit: 1636

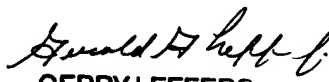
application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David A. Lambertson whose telephone number is (703) 308-8365. The examiner can normally be reached on 6:30am to 4pm, Mon.-Fri., first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Remy Yucel, Ph.D. can be reached on (703) 305-1998. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David A. Lambertson  
AU 1636

  
**GERRY LEFFERS**  
**PRIMARY EXAMINER**